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November 24, 2009

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Technology Center 2100

In re Application of:
Ray Y. Lai
Application No. 10/692913
Filed: 10/27/2003
Docket NO : 5681-66303
For: SYSTEM AND METHOD FOR INTEGRATION
OF WEB SERVICES

)
) **DECISION ON REQUEST TO**
) **RECONSIDER WITHDRAWAL OF**
) **RESTRICTION REQUIREMENT**
)
)

This decision is in response to petition filed September 26, 2008 requesting withdrawal of a restriction requirement in an Office Action mailed May 2, 2007.

The request for withdrawal of restriction is **GRANTED**.

Petitioner requests withdrawal of the restriction requirement on the following grounds:

1a. The basis for the restriction requirement is improper as the specification "does not describe inventions I-VIII as non-overlapping subcombinations usable together in a single combination". In support of this position, Petitioner alleges that as disclosed in the specification, the method of Inventions V and VII could each be carried out using the system of Invention I and that that systems of Inventions I and II could be each be used to generate an integrated web service architecture. Thus, petitioner concludes that the inventions as disclosed in the specification are not subcombinations of a single combination.

1b. Petitioner additionally notes that MPEP 806.05(d) requires that subcombinations do not overlap in scope" and that MPEP 806.05(j) "equates the requirement of 'do not overlap in scope' with 'mutually exclusive'". Petitioner provides an example of a seat bracket and a claim to a gear mechanism of a bicycle system as two non-overlapping mutually exclusive components of a larger system.

In response, it is first respectfully asserted that the phrase non-overlapping in scope does not imply that no common elements may exist between the two components of the larger system. Instead, the scope of one sub-combination should not be subsumed by the scope of the other sub-combination. MPEP 806.05 for example notes that "Related inventions in the same statutory class are considered mutually exclusive, or not overlapping in scope, if a first invention would

not infringe a second invention, and the second invention would not infringe the first invention.” There no requirement that the elements of the sub-combinations be totally different. However, a review of the specification reveals that the Inventions I-VII are not each related as subcombinations usable together. It should be noted that this decision makes no judgment that none of the disclosed embodiments may later be shown to be subcombinations useable together, merely that all groupings listed in the rejection of May 2007 are not so related.

2.. Petitioner next alleges that MPEP 806.05(d) requires the Examiner to show “by way of example that one of the subcombinations has utility other than in the disclosed combination”. However, MPEP 806.05(d) reproduced below makes this requirement where there are claims to a subcombination and to a combination requiring the particulars of the subcombination.

To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary. Each subcombination is distinct from the combination as claimed if:

- (A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in another materially different combination.

3. As a third point of traversal, Petitioner alleges that the examiner has failed to address the requirement of burden on the examination. MPEP 808.02 requires that if the claimed invention is “shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required”. A review of the May 2007 and of the July 2007 Office Actions reveals that the examiner did not in fact address this issue.

4. For reasons addressed above, the request for withdrawal of the restriction requirement is hereby **GRANTED**. The application is being forwarded to the examiner for handling consistent with this decision.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3591.

/Gail O. Hayes/
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Computer Architecture, Software, and
Information Security



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,913	10/24/2003	Ray Y. Lai	5681-66303	9034
58467	7590	11/25/2009		
MHKKG/SUN P.O. BOX 398 AUSTIN, TX 78767			EXAMINER WANG, JUE S	
			ART UNIT 2193	PAPER NUMBER
			NOTIFICATION DATE 11/25/2009	DELIVERY MODE ELECTRONIC

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